

## REMARKS

In the above amendments, Claim 1 has been amended to more clearly define the subject matter of the claimed invention, and Claims 3 and 6 have been amended to change their dependencies. Claims 2, 4 and 5 have been cancelled.

Claims 1, 3, 6 and 7 are pending in the present application.

### Provisional Obviousness-type Rejection

Claims 1 to 7 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending application No. 11/589,542.

In this regard, a terminal disclaimer is being submitted, along with this paper, under 35 U.S.C. § 253 and 37 CFR § 1.321(c). Applicant therefore respectfully requests the Examiner to withdraw this double-patenting rejection.

### Claim Rejections Under 35 U.S.C. §102

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Bae (U.S. Patent No. 6,552,316).

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Applicant has amended Claim 1 to further include subject matters recited in Claim 2, which is now cancelled.

The amended Claim 1 includes, *inter alia*, the following limitations:

“the electromagnetic wave detection means includes a user interface that comprises mode selection means capable of allowing the operator to select mode 1 using only the optical detection means or mode 2 using both the optical detection means and the electromagnetic wave detection means, and display means capable of displaying a selected mode”.

As above, the amended Claim 1 includes *a user interface having mode selection means and display means*. As Examiner admitted on page 4 of the outstanding Office Action, however, Bae does not teach or suggest a user interface as claimed in the amended Claim 1.

Therefore, it is respectfully submitted that Bae does not anticipate the claimed invention by failing to disclose or suggest all the elements and limitations in the amended Claim 1. Applicant respectfully requests the Examiner to withdraw the rejection on Claim 1 under 35 U.S.C. §102.

### **Claim Rejections Under 35 U.S.C. §103**

Claims 2-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bae.

In order for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See MPEP 2143.

Establishing a *prima facie* case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant’s

invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levingood*, 28 U.S.P.Q. 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In re Skill*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

Claims 2, 4 and 5 have been cancelled and Claims 3 and 6 have been amended, leaving that Claims 3, 6 and 7 are dependent from the amended Claim 1 directly or indirectly.

As discussed above in connection with 102 rejection, the amended Claim 1 includes *a user interface having mode selection means and display means*. The mode selection means is configured for an operator to select a mode 1 or a mode 2 and thus selectively operate an optical detection means or both the optical detection means and an electromagnetic wave detection means, depending upon welding or cutting conditions. The display means is designed to display, for example, the selected mode.

Bae is directed to a glare protecting device for automatically controlling transmission of light generated by a welding or cutting torch. In Bae, there is no teaching or suggestion about a user interface for selecting a mode to selectively operate an optical detection means or both the optical detection means and an electromagnetic wave detection means, and displaying the selected mode.

The Examiner stated in the rejection that the use of a display device with user interface for providing better visual operating functions in an optical system would have been obvious to one of ordinary skill in the art. The user interface of claimed invention is especially designed to include mode selection means and display means that are operatively coupled to an optical detection means and an electromagnetic wave detection means, thereby allowing an operator to select and display an appropriate operational mode, depending upon welding or cutting conditions. Therefore, Applicant respectfully submits that the user interface of the claimed invention is not obvious to one of ordinary skill in the art.

It is therefore submitted that Bae neither discloses nor suggests the subject matter claimed in amended Claim 1. Accordingly, *prime facie* obviousness does not exist regarding the

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subject matter claimed in Claim 1 with respect to the Bae reference. Applicant respectfully submits that Claim 1 is now allowable. Claims 3, 6 and 7 are also believed to be allowable, by virtue of their direct or indirect dependency from Claim 1.

**Conclusion**

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Reconsideration and subsequent allowance of this application are courteously requested.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

The Examiner is invited to contact Applicants' Attorneys at the below-listed telephone number with any questions or comments regarding this Response or otherwise concerning the present application.

Respectfully submitted,

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